

REMARKS

The Examiner rejected claims 1-2 under 35 U.S.C. §102(c) as allegedly being anticipated by Fischer (US 2002/0010638). Since claims 1-2 have been canceled, the rejection of claims 1-2 under 35 U.S.C. §102(c) is moot.

The Examiner rejected claims 3-5 under 35 U.S.C. §103(a) as allegedly being unpatentable over Fischer in view of Bando et al (US 6,405,244).

The Examiner rejected claim 6 under 35 U.S.C. §103(a) as allegedly being unpatentable over the modified Fischer and Bando et al system and further in view of Davis et al (US 5,937,160).

The Examiner rejected claims 8-11 and 13-14 under 35 U.S.C. §103(a) as allegedly being unpatentable over the modified Fischer, Bando et al, and Davis et al system and further in view of MSA (post by Arthur Urbanowicz).

Applicants respectfully traverse the §103(a) rejections with the following arguments.

35 U.S.C. §103(a)Claims 3-5

The Examiner rejected claims 3-5 under 35 U.S.C. §103(a) as allegedly being unpatentable over Fischer in view of Bando et al (US 6,405,244).

Applicants respectfully contend that claim 3 is not unpatentable over Fischer in view of Bando, because Fischer and further in view of Bando does not teach or suggest each and every feature of claim 3. For example, Fischer and further in view of Bando does not teach or suggest the feature: **reading from a memory an authentication key associated with the originator; including the authentication key in an open field of the electronic mail; and sending the electronic mail from the originator to the recipient**" (emphasis added).

The Examiner argues: "Bando et al teaches reading authentication information associated with the originator (see column 5 line 54 through column 6 line 6).... At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Bando et al's method of reading authentication information in the email authentication method of Fischer.... Motivation to do so would have been to decide that falsification or alteration has not been performed (see Bando et al column 6 lines 1-6)."

In response, Applicants respectfully contend that the Examiner's argument for modifying Fischer by the alleged teaching of Bando is not persuasive.

A first reason why Examiner's argument for modifying Fischer by the alleged teaching of Bando is not persuasive is that the Examiner's argument has no relevance to claim 3. In particular, the Examiner's citation of Bando, col. 5, line 66 - col. 6, line 6 is alleged by the

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Examiner to enable the receiver of the electronic mail to decide that falsification or alteration has not been performed. However, the steps of claim 3 are performed by the sender of the message and not by the receiver of the message. Since the receiver of the electronic mail, and not the sender of the electronic mail, allegedly receives the benefit of deciding that falsification or alteration of the electronic mail has not been performed, it is therefore not obvious to modify Fischer in relation to claim 3 based on the Examiner's argument.

A second reason why Examiner's argument for modifying Fischer by the alleged teaching of Bando is not persuasive is that reading an authentication key from memory is not necessary for being able to decide that falsification or alteration has not been performed. Applicants maintain that the ability to decide that falsification or alteration has not been performed requires the ability to verify the presence of the authentication key in the open field of the electronic mail, which does not require that the authentication key be read from memory.

A third reason why Examiner's argument for modifying Fischer by the alleged teaching of Bando is not persuasive is that the ability to decide that falsification or alteration has not been performed requires the ability to verify the presence of the authentication key in the open field of the electronic mail, which neither Fischer nor Bando disclose, as admitted by the Examiner in the office action on page 5, lines 3-5.

Based on the preceding arguments, Applicants respectfully maintain that claim 3 is not unpatentable over Fischer in view of Bando, and that claim 3 is in condition for allowance. Since claims 4-5 depend from claim 3, Applicants contend that claims 4-5 are likewise in condition for allowance.

Claims 6-7 and 12

The Examiner rejected claims 6-7 under 35 U.S.C. §103(a) as allegedly being unpatentable over the modified Fischer and Bando et al system and further in view of Davis et al (US 5,937,160).

Applicants respectfully contend that claim 6 is not unpatentable over the modified Fischer and Bando system and further in view of Davis, because the modified Fischer and Bando system and further in view of Davis does not teach or suggest each and every feature of claim 6. For example, the modified Fischer and Bando system and further in view of Davis does not teach or suggest the feature: "determining whether an authentication key is present in an open field of the electronic mail" (emphasis added).

The Examiner argues: "Davis et al teaches determining whether a type of information is present in an open field of the electronic mail (see column 11 lines 25-42). At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Davis et al's method of determining the presence of information in the subject field to determine if the authentication information of the modified Fischer and Bando et al system is present. Motivation to do so would have been to allow for different actions to occur based on the information in the subject (see Davis et al column 11 lines 25-42)."

In response, Applicants respectfully contend that the Examiner's argument for modifying Fischer and Bando by the alleged teaching of Davis is not persuasive, because the disclosure by Davis, col. 11, lines 25-42 does not address an authentic key with respect to the feature of claim 6 of "determining whether an authentication key is present in an open field of the electronic mail" (emphasis added). In other words, Davis does not teach or suggest the preceding feature of

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claim 6 as alleged by the Examiner. The Examiner has not provided argumentation to modify Davis to disclose "determining whether an authentication key is present in an open field of the electronic mail" (emphasis added). Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness in relation to claim 6.

Based on the preceding arguments, Applicants respectfully maintain that claim 6 is not unpatentable over the modified Fischer and Bando system and further in view of Davis, and that claim 6 is in condition for allowance. Since claim 7 depends from claim 6, Applicants contend that claim 7 is likewise in condition for allowance.

As to claim 12, the Examiner argues: "As per claim 12, the modified Fischer, Bando et al, and Davis et al system discloses claimed material as applied to claims 1 and 6."

In response, Applicants refer to Applicants' arguments *supra* in relation to claims 1 and 6.

Claims 8-11 and 13-14

The Examiner rejected claims 8-11 and 13-14 under 35 U.S.C. §103(a) as allegedly being unpatentable over the modified Fischer, Bando et al, and Davis et al system and further in view of MSA (post by Arthur Urbanowicz).

Applicants respectfully contend that claim 8 is not unpatentable over the modified Fischer, Bando, and Davis system and further in view of MSA, because the modified Fischer, Bando, and Davis system and further in view of MSA does not teach or suggest each and every feature of claim 8. For example, the modified Fischer, Bando, and Davis system and further in

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view of MSA does not teach or suggest the features: "when an authentication key is expected to be present, determining whether the authentication key is present; and rejecting the electronic mail when the authentication key is not present".

The Examiner alleges that page 1 of MSA discloses the preceding features of claim 8. However, Applicants cannot find the preceding features of claim 8 on page 1 of MSA. Therefore, Applicants respectfully request that the Examiner provide an analysis of page 1 of MSA explaining how MSA discloses the preceding features of claim 8.

Based on the preceding arguments, Applicants respectfully maintain that claim 8 is not unpatentable over the modified Fischer, Bando, and Davis system and further in view of MSA, and that claim 8 is in condition for allowance.

Applicants respectfully contend that claim 9 is not unpatentable over the modified Fischer, Bando, and Davis system and further in view of MSA, because the modified Fischer, Bando, and Davis system and further in view of MSA does not teach or suggest each and every feature of claim 9. For example, the modified Fischer, Bando, and Davis system and further in view of MSA does not teach or suggest the features: "when an authentication key is expected to be present, determining whether the authentication key is present; when the authentication key is not present, rejecting the electronic mail; and when the authentication key is present, determining whether the authentication key is associated with the originator, accepting the electronic mail when the authentication key is associated with the originator, and rejecting the electronic mail when the authentication key is not associated with the originator."

The Examiner alleges that page 1 of MSA discloses the preceding features of claim 9. However, Applicants cannot find the preceding features of claim 9 on page 1 of MSA. Therefore, Applicants request that the Examiner provide an analysis of page 1 of MSA explaining how MSA discloses the preceding features of claim 9.

Based on the preceding arguments, Applicants respectfully maintain that claim 8 is not unpatentable over the modified Fischer, Bando, and Davis system and further in view of MSA, and that claim 9 is in condition for allowance. Since claims 10-11 depend from claim 9, Applicants contend that claims 10-11 are likewise in condition for allowance.

In addition with respect to claim 10, Applicants respectfully contend that Fischer, Bando, and Davis system and further in view of MSA does not disclose the feature: "reading a memory at an address that is dependent upon a source identifier that identifies the originator".

The Examiner argues: "see MSA where the trusted server name is inherently stored in memory".

In response, Applicants dispute the Examiner's contention that "the trusted server name is inherently stored in memory". Moreover, Applicants contend that an argument of inherency cannot be used in a rejection under 35 U.S.C. §103(a) unless the Examiner can demonstrate with evidence that the alleged inherency was known to a person of ordinary skill in the art at the time that the invention was made, which the Examiner has not done. See *In re Shetty*, 566 F.2d 81, 86, 195 U.S.P.Q. 753, 756-57 (C.C.P.A. 1977) (reversing the Board's rejection of a claim based on alleged inherency under 35 U.S.C. 103 of a method to curb appetite, and stating: "[t]he

inherency of an advantage and its obviousness are entirely different questions. That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown").

Moreover, the preceding argument by the Examiner is unrelated to "an address that is dependent upon a source identifier that identifies the originator". The Examiner has not presented any argument directed to said "address".

In addition with respect to claim 11, Applicants respectfully contend that Fischer, Bando, and Davis system and further in view of MSA does not disclose the feature: "reading a memory at an address that is dependent upon a source identifier that identifies the originator".

The Examiner argues that the preceding feature of claim 11 is disclosed in Bando, col. 5, line 54 - col. 6, line 6.

In response, Applicants dispute the Examiner's contention that the preceding feature of claim 11 is disclosed in Bando, col. 5, line 54 - col. 6, line 6. Indeed, Bando, col. 5, line 54 - col. 6, line 6 is totally silent as to said "address".

Applicants respectfully contend that claim 13 is not unpatentable over the modified Fischer, Bando, and Davis system and further in view of MSA, because the modified Fischer, Bando, and Davis system and further in view of MSA does not teach or suggest each and every feature of claim 13. For example, the modified Fischer, Bando, and Davis system and further in view of MSA does not teach or suggest the features: "determining whether an authentication key is expected to be present in an open field of the electronic mail; when an authentication key is expected to be present, determining whether the authentication key is present; and rejecting the

electronic mail when the authentication key is not present in the open field of the electronic mail".

The Examiner relies on the Examiner's arguments relating to claims 12 and 9. In response, Applicants rely on Applicants' arguments relating to claims 12 and 9.

Based on the preceding arguments, Applicants respectfully maintain that claim 13 is not unpatentable over the modified Fischer, Bando, and Davis system and further in view of MSA, and that claim 13 is in condition for allowance.

Applicants respectfully contend that claim 14 is not unpatentable over the modified Fischer, Bando, and Davis system and further in view of MSA, because the modified Fischer, Bando, and Davis system and further in view of MSA does not teach or suggest each and every feature of claim 14. For example, the modified Fischer, Bando, and Davis system and further in view of MSA does not teach or suggest the features: "receiving the electronic mail from an originator, the electronic mail having been previously prepared for sending from the originator with a source identifier to the recipient with a destination identifier; determining whether an authentication key is expected to be present in an open field of the electronic mail; when the authentication key is not expected to be present, accepting the electronic mail; when the authentication key is expected to be present, determining whether the authentication key is present; when the authentication key is present, determining whether the authentication key is associated with the originator and further associated with the recipient; accepting the electronic mail when the authentication key is determined to be associated with the originator and the recipient; rejecting the electronic mail when the authentication key is determined not to be

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associated with the originator and further associated with the recipient; and when the authentication key is not present, rejecting the electronic mail”.

The Examiner argues: “see rejection of above claims where it is inherent that every email has a source and destination identifier”.

In response, Applicants dispute the Examiner’s contention that “it is inherent that every email has a source and destination identifier”. Applicants contend that an argument of inherency cannot be used in a rejection under 35 U.S.C. §103(a) unless the Examiner can demonstrate with evidence that the alleged inherency was known to a person of ordinary skill in the art at the time that the invention was made, which the Examiner has not done. See *In re Shetty*, 566 F.2d 81, 86, 195 U.S.P.Q. 753, 756-57 (C.C.P.A. 1977) (reversing the Board’s rejection of a claim based on alleged inherency under 35 U.S.C. 103 of a method to curb appetite, and stating: “[t]he inherency of an advantage and its obviousness are entirely different questions. That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown”).

Based on the preceding arguments, Applicants respectfully maintain that claim 14 is not unpatentable over the modified Fischer, Bando, and Davis system and further in view of MSA, and that claim 14 is in condition for allowance.

CONCLUSION

Based on the preceding arguments, Applicants respectfully believe that all pending claims and the entire application meet the acceptance criteria for allowance and therefore request favorable action. If the Examiner believes that anything further would be helpful to place the application in better condition for allowance, Applicants invites the Examiner to contact Applicants' representative at the telephone number listed below. The Director is hereby authorized to charge and/or credit Deposit Account 09-0457.

Date: 05/02/2005

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